

RECEIVED
CENTRAL FAX CENTER
APR 06 2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 30004777-1US

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John BRASSIL et al.

Confirmation No.: 4801

Application No.: 09/876,268

Examiner: MD S. Elahee

Filing Date: June 7, 2001

Group Art Unit: 2646

Title: CENTRALIZED DATA POSITION INFORMATION STORAGE SYSTEM AND METHOD

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1460
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on February 6, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1580

☐ The extension fee has already been filed in this application.

☐ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300.

Date of facsimile: April 6, 2006

Typed Name: Donna L. Lizama

Signature: 

Respectfully submitted,

John BRASSIL et al.

By 

Allan M. Lowe

Attorney/Agent for Applicant(s)

Reg No. : 19,841

Date : April 6, 2006

Telephone : 703.684.1111

Randy Noranbrock
Registration No. 42,940

Rev 10/06 (Ap/Ener)

BEST AVAILABLE COPY

RECEIVED
CENTRAL FAX CENTER

APR 06 2006

PATENT

Docket No. 30004777-1 US (1509-185)

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	
Inventors: John BRASSIL et al.	: Confirmation No: 4601
	:
U.S. Patent Application No. 09/875,266	: Group Art Unit: 2645
	:
Filed: June 7, 2001	: Examiner: Md S. ELAHEE
	:
For: CENTRALIZED DATA POSITION INFORMATION STORAGE SYSTEM AND METHOD	

MailStop Appeal Briefs – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Further to the Notice of Appeal filed February 6, 2006, in connection with the above-identified application on appeal, herewith is Appellant's Brief on Appeal. The Commissioner is authorized to charge Deposit Account No. 08-2025 in the amount of \$500 for the statutory fee.

To the extent necessary, Appellant hereby requests any required extension of time under 37 C.F.R. §1.136 and hereby authorizes the Commissioner to charge any required fees not otherwise provided for to Deposit Account No. 08-2025.

04/07/2006 TL0111 00000065 002025 09875266
01 FC:1402 500.00 DA

BEST AVAILABLE COPY

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

TABLE OF CONTENTS

I.	Real Party in Interest	6
II.	Related Appeals and Interferences	6
III.	Status of Claims	6
IV.	Status of Amendments	6
V.	Summary of Claimed Subject Matter	6
VI.	Grounds of Rejection to be Reviewed on Appeal	12
A.	Claims 16 and 18 comply with the written description requirement of 35 USC 112, first paragraph.	12
B.	The words "one of the at least one second communications device" in claim 18, lines 2 and 3 have sufficient antecedent basis so the rejection of claim 18 under 35 USC 112, second paragraph, as being indefinite, is incorrect.	12
C.	Claims 1-5, 10 and 17 are not anticipated by Rautila et al., US Patent 6,549,625	12
D.	Claims 6 and 7 are not obvious as a result of Rautila et al. and Ramachandran et al., US Patent Publication 2001/0044747	12
E.	Claims 8 and 9 are not obvious as result of Rautila et al. and Hitchings Jr., US Patent 6,594,484	12
F.	Claim 11 is not obvious as result of Rautila et al. and Kumar et al., US Patent Publication 2002/0143634	12
G.	Claims 12, 14 and 15 are not obvious as a result of Rautila et al. and Ramachandran et al.	12
H.	Claim 16 is not obvious as result of Rautila et al., Ramachandran et al. and Pradhan et al., US Patent Publication 2002/0160793	12
VII.	Argument	12
A.	Claims 16 and 18 comply with the written description requirement of 35 USC 112, first paragraph.	12

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

1.	Claim 16.....	12
2.	Claim 18.....	13
B.	The citation "one of the at least one second communications device" in claim 18, lines 2 and 3 has sufficient antecedent basis so the rejection of claim 18 under 35 USC 112, second paragraph, as being indefinite, is incorrect.....	14
C.	Claims 1-5, 10 and 17 are not anticipated by Rautila et al., US Patent 6,549,625.....	14
1.	Claim 1 includes limitations Rautila et al. does not disclose.....	14
2.	Claim 2 includes a limitation Rautila et al. fails to include.....	17
3.	Claim 3 includes a limitation Rautila et al. fails to include.....	17
4.	Claim 4 includes a limitation Rautila et al. fails to include.....	18
5.	Claim 5 is not anticipated by Rautila et al.....	19
6.	Independent claim 10 is not anticipated by Rautila et al.....	20
7.	Independent claim 17 is not anticipated by Rautila et al.....	21
D.	Claims 6 and 7 are not obvious as a result of Rautila et al. and Ramachandran et al., US Patent Publication 2001/0044747.....	22
E.	Claims 8 and 9 are not obvious as result of Rautila et al. and Hitchings Jr., US Patent 6,594,484.....	23
1.	The obviousness rejection of claim 8 is wrong.....	23
2.	Claim 9 is not obvious.....	23
F.	Claim 11 is not obvious as result of Rautila et al. and Kumar et al., US Patent Publication 2002/0143634.....	24
G.	Claims 12, 14 and 15 are not obvious as a result of Rautila et al. and Ramachandran et al.....	25
1.	Claim 12 is not obvious from Rautila et al. and Ramachandran et al.....	25
2.	Claim 14 is not obvious from Rautila et al. and Ramachandran et al.....	26
3.	Claim 15 is not rendered obvious by Rautila et al. and Ramachandran et al.....	27
H.	Claim 16 is not obvious as result of Rautila et al., Ramachandran et al. Pradhan et al., US Patent Publication 2002/0160793.....	28
VIII.	Conclusion.....	29
IX.	Claims Appendix.....	30
X.	Evidence Appendix.....	36

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

XI. Related Proceedings Appendix..... 37

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

TABLE OF AUTHORITIES**Cases**

<u>Ex parte Levy</u> , 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).	19
<u>In re Oelrich</u> , 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).....	18
<u>In re Rijckaert</u> , 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).....	18
<u>In re Roberston</u> , 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).....	18

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

I. Real Party in Interest

The real party in interest is Hewlett Packard Development Company, L.P., a Texas limited partnership.

II. Related Appeals and Interferences

There are no related appeals and/or interferences.

III. Status of Claims

Claims 1-12 and 14-18 are pending. Claim 13 has been canceled. No claims are allowed. Claim 18 is indicated as being allowable if the rejections thereof under 35 U.S.C. 112 first and second paragraphs are overcome.

IV. Status of Amendments

There was no amendment after final rejection. An amendment correcting an antecedent problem is submitted herewith. Appellants presume the amendment will be entered and will proceed on that presumption.

V. Summary of Claimed Subject Matter

Independent method claims 1 and 17 are directed to a method of transferring data to a first communication device M1 (in the form of a mobile phone), Figure 1, having (1) a first transceiver 3, Figure 2, for communication at a first data rate over a long-range and (2) a second transceiver 5, Figure 2, for communication at a second, higher data rate over a short range. The method is performed by using a coordinated short-range wireless network, Figure

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

1, including communications device M1 and a second communications device M2 that is similar to M1. M1 and M2 are configured as illustrated in Figure 2 to include processor 7, music player 9 (in the form of an MP3 player) and memory 8 (page 2, lines 3-9, page 5, lines 3-21) as set forth, inter alia, in independent claim 12, directed to a communications device. Communications devices M1 and M2 also include filter 10 including a list of items of interest to the user of communications device M1 for enabling only certain music files from communications device M2 to be downloaded from short-range transceiver 5 to memory 8, as required by claim 16 that depends upon claim 12 (page 5, line 26-page 6, line 2 and page 6, lines 23-26).

In the method of claim 1, communication is initiated between communications devices M1 and M2 and/or M3 to establish whether or not communications device M2 and/or M3 has data required (indicated by claim 7 to be an MP3 file) by communications device M1 (page 2, lines 10-13 and page 5, lines 23-28). Upon the first communications device M1 receiving confirmation that a second communications device M2 or M3 has the required data, the first communications device M1 uses its low-speed first transceiver 3 to communicate with service provider 1 to request permission for transfer of all of the required data from the second communications device M2 or M3 to the first communications device M1 (page 2, lines 14-19 and page 6, lines 4-9). The required data are transferred from the second communications device M2 or M3 to the first communications device M1 following transmission of authorization by service provider 1 to the first communications device M1 (page 2, lines 19-21 and page 6, lines 9-11). Independent method claim 17 is similar to claim 1 but indicates more specifically that the communications between the short-range transceivers 5 are wireless and requires the step of establishing whether the second communications device M2 or M3 has data

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

required by the first communications device M1 to be as a result of the initial communication between the short-range high data rate transceivers thereof (page 6, lines 7-11).

As set forth in claim 2, that depends on claim 1, service provider 1 transmits provisional permission and costing to low-speed first transceiver 3 of communications device M1, wherein such permission is transmitted prior to the required data being transferred from communications device M2 to communications device M1 (page 2, lines 23 and 24 and page 6, lines 9-17). Claim 3 indicates the first communications device M1 using its first, low speed transceiver 3, transmits a message accepting the costing to the service provider 1 (page 2, lines 26-28 and page 6, lines 13-15). Claim 4 indicates service provider 1 issues an authorization once acceptance of the costing has been received from the first communications device M1 (page 2, lines 28 and 29 and page 6, lines 13-17). Claim 5 requires service provider 1 to communicate the costing to a network service provider of the first communications device M1 (page 2, lines 28-31 and page 6, lines 17-19). As required by claim 6, once the authorization has been received the second, high speed transceiver 5 of the first communications device M1 communicates with the second communications device M2 or M3 to inform the second communications device that authorization has been received and to request downloading of the required data (page 3, lines 1-4 and page 6, lines 21-23).

Dependent claim 8 indicates a list of required data files is initially supplied to memory 8 of the first communications device M1, while claim 9 indicates the list of required data files is communicated by the second, high speed transceiver 5 of the first communications device M1 to second communications device M2 and/or M3 (page 3, lines 6-11 and page 6, lines 23-26).

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

Claim 18 depends on claim 1 and requires data to be transferred to the second communications devices M2 and/or M3. Communication is initiated between the second communication device M2 or M3 and the first communication device M1 to establish whether or not the first communication device M1 has data required by the second communications device M2 or M3 (page 7 lines 20-28). Upon the second communications device M2 receiving confirmation that the first communications device M1 has the required data, the second communications device M2 communicates with service provider 1 using the first long-range, low data rate transceiver 3 of the second communications device M2 to request permission for the transfer of the required data from the first communications device M1 to the second communications device M2 (page 7, lines 20-28). The required data are transferred from the first communications device M1 to the second communications device M2 following transmission of authorization by service provider 1 (page 7, lines 20-28).

Method claim 10 is concerned with a method of purchasing goods using a first communication device M1 having a first transceiver 3 for communication at a first data rate over a long range and a second transceiver 5 for communication at a second, higher data rate over a short-range (page 3, lines 12-16 and page 8, lines 10-12). The method includes the step of inputting details of an intended purchase into memory 8 of the first communication device M1 (page 3, lines 17 and 18) and page 8, lines 11 and 12). The second transceiver 5 of the first communications device M1 transmits details of the intended purchase to any similar, in-range transceiver 5 of a communication device associated with a supplier (page 3, lines 19-22 and a page 8, lines 12-14). The second, high speed, short-range transceiver 5 of communications device M1 receives a communication from a similar, high speed, short-range transceiver indicating that (1) the intended purchase is available and (2) the cost of the good (page 3 lines

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

23-25 and page 8, lines 14-16). Upon receiving such a communication from the supplier, the first communications device M1 communicates with a payment facility using its first, low data rate, long-range transceiver 3 (page 3, lines 26 and 27 and page 8, lines 17-19). In response to payment authorization being received from the payment facility, the first communications device M1 places an order for the intended purchase with the supplier using its second, high speed, short-range transceiver 5 (page 3 lines 29-31 and page 8, line 19).

Claim 11, dependent upon claim 10, requires a payment facility to communicate the cost of the intended purchase to a banking facility associated with the user of the first communication device M1 upon the first communications device communicating to the payment facility that the order has been made (page 4, lines 1-4).

Independent Claim 12 is directed to a communication device including first and second transceivers 3 and 5, music player 9, memory 8 and processor 7. The first transceiver communicates at a low data rate over a long range, while the second transceiver communicates at a second, higher data rate over a short range. The processor 7 controls downloading of music files to memory 8 and transferring of music files from memory 8 to music player 9. The processor 7 is programmed to control the high speed, short-range second transceiver 5 to request downloading of a given music file at the second, high-speed data rate from a similar communications device M2 or M3 within the range of the short-range, second transceiver 5 (page 4 lines 12-19 and page 6, lines 28 -32).

Claim 14 depends on claim 12 and requires processor 7 to be programmed to control the low speed, long-range transceiver 3 to request permission from service provider 1 to download

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

the given music file from a similar communication device M2 or M3 holding the music file in its memory (page 4, lines 14-16 and page 6, lines 13-32).

Claim 15, dependent on claim 14, indicates processor 7 is programmed to control the high speed, short-range transceiver 5 to request downloading of the music file once authorization is received from service provider 1 (page 4, lines 17-19 and page 6, lines 13-32).

Claim 16, dependent upon claim 12, requires filter 10 of communications device M1 to enable downloading to memory 8 of communications device M1 of only certain music files from the similar communications device M2 or M3. The downloading is via the second, high-speed, short-range transceiver 5 of M1 (page 5 line 23-page 6, line 26).

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

VI. Grounds of Rejection to be Reviewed on Appeal

- A. Claims 16 and 18 comply with the written description requirement of 35 USC 112, first paragraph.**
- B. The words "one of the at least one second communications device" in claim 18, lines 2 and 3 have sufficient antecedent basis so the rejection of claim 18 under 35 USC 112, second paragraph, as being indefinite, is incorrect.**
- C. Claims 1-5, 10 and 17 are not anticipated by Rautila et al., US Patent 6,549,625.**
- D. Claims 6 and 7 are not obvious as a result of Rautila et al. and Ramachandran et al., US Patent Publication 2001/0044747.**
- E. Claims 8 and 9 are not obvious as result of Rautila et al. and Hitchings Jr., US Patent 6,594,484.**
- F. Claim 11 is not obvious as result of Rautila et al. and Kumar et al., US Patent Publication 2002/0143634.**
- G. Claims 12, 14 and 15 are not obvious as a result of Rautila et al. and Ramachandran et al.**
- H. Claim 16 is not obvious as result of Rautila et al., Ramachandran et al. and Pradhan et al., US Patent Publication 2002/0160793.**

VII. Argument

- A. Claims 16 and 18 comply with the written description requirement of 35 USC 112, first paragraph.**

- 1. Claim 16**

The final rejection, in item 5, page 6, erroneously states the limitation of claim 16 for a filter for enabling only certain music files from the similar communications device to be downloaded from the second transceiver into the memory does not meet the written description requirement of 35 USC 112, first paragraph. Page 5, lines 20 and 21 indicates memory 8 stores an average length MP3 music file. Page 5, line 29-page 6, line 2 indicates filter 10 is a list of items of interest, including MP3 music files. As such, filter 10 enables downloading of only MP3 music files of interest to the memory 8 of device M1, to satisfy the language of claim 16.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

2. Claim 18

The final rejection, in item 6, bridging pages 6 and 7, erroneously states the specification fails to describe the limitation of claim 18 for a second communications device having a first transceiver and a second transceiver and a second communications device that receives confirmation that the first communications device has the required data, with the service provider using its first transceiver to request permission for the transfer of the required data from the first communications device to the second communications device. The foregoing requirement of claim 18 indicates the second communications device M2 communicates with service provider by using the first transceiver 3 of the second communications device M2 to request permission for the transfer of the required data from the first communications device M1 to the second communications device M2. The transfer is upon the second communications device M2 receiving confirmation that the first communication device M1 has the required data.

These limitations are described on page 6, lines 4-11 and page 7, lines 11-13 of the specification. Page 6, lines 4-11 indicates the confirmation is granted to the first communications device M1. Page 7, lines 11-13 indicates the confirmation can be sent by either the mobile phone M1 or the mobile phone M2 over the slow-speed cellular network including transceiver 3. Thus, the specification provides description of claim 18.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

- B. The citation "one of the at least one second communications device" in claim 18, lines 2 and 3 has sufficient antecedent basis so the rejection of claim 18 under 35 USC 112, second paragraph, as being indefinite, is incorrect.**

Claim 18 depends on claim 1 that calls for "at least one second communications device." The reference in claim 18 to "one of the at least one second communications device" clearly refers to the "at least one second communications device" of claim 1.

- C. Claims 1-5, 10 and 17 are not anticipated by Rautila et al., US Patent 6,549,625.**

1. Claim 1 includes limitations Rautila et al. does not disclose.

The final rejection of claim 1, on page 8, incorrectly alleges column 7, lines 1-10 of Rautila et al. indicate mobile terminal 12 and vending machine 27" or location based device 25 are respectively the similar first and second communications devices of claim 1 that are respectively required to have first and second transceivers for communication at a first data rate over a long range and communication at a second, higher data rate over a short range. Mobile terminal 12 and vending machine 27" or location based device 25 cannot be considered similar type devices. Mobile terminal 12 is obviously mobile and includes (1) a short-range transceiver 44 (Figure 2) that communicates with broadcast locations 16 via link 24 and (2) a network transceiver 46 that communicates via link 42 to IP network 26 including servers with databases; see col. 8, lines 42-52. Thus, because there is no disclosure of vending machine 27" or location based device 25 including a network transceiver or being mobile, vending machine

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

27'" or location based device 25 is not similar to mobile terminal 12. In fact, it is evident that vending machine 27'" and location based device 25 do not include a network transceiver because they only communicate with broadcast location 16 via short range links 27" that are within the confines of short-range broadcast area 18; see column 6, lines 27-29.

The allegations concerning column 7, lines 1-10 in the penultimate and antepenultimate paragraphs on page 8 of the final rejection are without foundation. Column 7, lines 1-10 of Rautila et al. is the end of a very convoluted sentence beginning at column 6, line 50 and which discusses information broadcast by position transceiver 14 that is at broadcast location 16; see column 6, lines 24-29. The sentence indicates position transceiver 14 transmits (1) advertisements, (2) information relating to making emergency calls, (3) information relating to providing navigation services to enable a user of mobile terminal 12 to move, (4) information relating to location and location based devices or services, and (5) information informing a user of mobile terminal 12 (column 6, lines 25 and 26) of special services.

The special services, enumerated in the portion of the sentence beginning at column 6, line 66 and continuing to the end of the sentence at column 7, line 10, include advertisement information relating to the price of goods or services and a requested form of payment indication, "with the user sending with the mobile terminal" 12 the requested form of payment to the database of the IP network 26 by using network transceiver 46. IP network 26 transmits acknowledgment of payment 27 from the IP network database to position transmitter 14 (col. 7, lines 5-7), not to mobile terminal 12, that the final rejection states is the first communications device of claim 1. Position transmitter 14, not IP network 26, transmits the payment acknowledgment 27' to the user of mobile terminal 12 and to location based device 25 via link 27" or to specialized service 25 via link 27" that provides the purchased goods (col. 7, lines 7-

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

10). Based on the foregoing, there is no communication initiated between mobile terminal 12 (alleged in the Final Rejection to be the first communications device of claim 1) and vending machine 27" or location based device 25 (alleged in the final rejection to be the second communications device of claim 1) to establish whether or not the vending machine or location based device has data required by mobile terminal 12.

Page 2 of the Final Rejection refers to a position transmitter, i.e., position transmitter 14, transmitting acknowledgement to provide permission to the user of mobile terminal 12 to have access to services. The reliance on page 2 of the Final Rejection of position transmitter 14 is contrary to the rationale set forth on the page 8 rejection of claim 1. In the rejection of claim 1, as set forth on page 8 of the Final Rejection, the first and second communication devices are stated to be mobile terminal 12 and vending machine 27"" or location base device 25. There is no reliance in the rejection of claim 1 on page 8 of a position transmitter, which the Rautila et al. drawing and specification clearly indicate is position transmitter 14. Consequently, the arguments set forth on page 2 are inconsistent with the rejection of claim 1, on page 8 of the Final Rejection. The Examiner can not have it both ways. He can not state in the rejection of claim 1 that the first and second communication devices are certain devices and in the argument on page 2 imply that one of the communication devices is a further structure.

Consequently, the anticipation rejection of claim 1 is wrong and the art rejections of all claims dependent on claim 1, i.e., claims 1-9 and 18, fall.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

2. Claim 2 includes a limitation Rautila et al. fails to include.

The allegation in the final rejection, page 9, first paragraph, that Rautila et al., at column 6, line 48-column 7, line 10, discloses the requirement of claim 2 for a service provider to transmit provisional permission, together with costing, to the first transceiver of the first communication device is wrong. There is no mention in column 6, line 48-column 7, line 10 of provisional permission or of costing being transmitted by IP network 26, no less to mobile terminal 12.

3. Claim 3 includes a limitation Rautila et al. fails to include.

The statement in the second paragraph on page 9 that column 6, line 48-column 7, line 10 of Rautila et al. discloses the requirement of claim 3 for the first communications device to transmit a message accepting the costing to the service provider is incorrect. There is no disclosure of the terminal 12 transmitting a message to network 26 accepting the cost.

The discussion of claim 3 at the top of page 3 of the Final Rejection states the user of mobile terminal 12 sends a payment request to network server 26 after the user receives advertisement information. The Examiner relies on column 4, lines 33-54, and column 6, line 48-column 7, line 10, for this statement. Column 4, lines 46-48, of Rautila et al. indicates the user of mobile terminal 12 sends the requested payment to Internet server 26 after receiving information from position transceiver 14. However, position transceiver 14 is not one of the first or second communications that is identified on page 8 of the Final Rejection, in connection with the rejection of claim 1, upon which claim 3 depends. Further, the user of mobile terminal 12 sends the requested payment, not a payment request, to Internet server 26.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

The last sentence in the paragraph at the top of page 3 of the Final Rejection states it is inherent that the user of mobile terminal 12 made a payment request after accepting payment for a service because the user made a payment request for the service. The rationale for inherency by the Examiner in this regard escapes appellants.

4. Claim 4 includes a limitation Rautila et al. fails to include.

The final rejection incorrectly states, in the third paragraph on page 9, that column 6, line 48-column 7, line 10 of Rautila et al. discloses the limitation of claim 4 for the service provider to issue an authorization once acceptance of the costing has been received from the first communication device. There is no disclosure of network 26 issuing an authorization as a result of acceptance of the costing being received by the network from mobile terminal 12. The final rejection alludes to "the service provider issuing inherently an authorization." While col. 7, lines 5 and 6, indicates network 26 transmits an acknowledgement of payment, payment acknowledgement is not a payment authorization.

The examiner has also failed to meet the requirements for a proper rejection based on inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Roberston, 169 F.3d 743, 745,

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). Since the Examiner has not provided a rationale or evidence to show that network 26 issues an authorization, the rejection of claim 4 based on Rautila et al. is incorrect and must be withdrawn.

The discussion of claim 4 in the only full paragraph on page 3 of the Final Rejection refers to position transmitter 14 transmitting acknowledgement and providing permission to the user of mobile terminal 12 to have access to services. The reference to position transmitter 14 is inconsistent with the rejection of claim 1 that says the first communication device is mobile terminal 12 and the second communication device is vending machine 27''' or location base service 25. In addition, the statement in the paragraph on page 3 dealing with claim 4 concerning the user of mobile terminal 12 sending a payment request to the network server is contrary to the statement in Rautila et al., at col. 7, lines 3 and 5, that the requested payment, not the payment request, is sent to the Internet server after the user of mobile terminal 12 receives information from position transceiver 14.

5. Claim 5 is not anticipated by Rautila et al.

The fourth paragraph on page 9 of the final rejection wrongly states that column 6, line 48-column 7, line 10 of Rautila et al. discloses the limitation of claim 5 requiring the service provider to communicate costing to a network service provider of the first communications device. The relied upon portion of the reference fails to disclose network 26 communicating costing to itself or to any other network service provider for mobile terminal 12.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

6. Independent claim 10 is not anticipated by Rautila et al.

In the rejection of independent claim 10, there is no identification of the structures of Rautila et al. that are alleged to read on (1) the first transceiver, (2) second transceiver, (3) a first communications device, and (4) a similar in-range transceiver, wherein the similar transceiver communicates at a higher data rate over a short range compared to the data rate of the first transceiver that communicates over a long range. Consequently, appellants are not in a position to determine exactly how the examiner interprets the various steps of claim 10 vis-à-vis Rautila et al. In any event, it is clear that column 4, lines 33-54 and column 6, line 48-column 7, line 10 of the reference do not disclose the claim 10 requirement for the first communications device to place an order for an intended purchase with a supplier in response to payment authorization being received from a payment facility. Column 4, lines 49-54 indicates the user of a mobile terminal, i.e. terminal 12, is permitted to have access to the purchased goods or services, rather than placing an order for an intended purchase.

In discussing independent claim 10 in the sentence bridging pages 4 and 5 of the Final Rejection, the Examiner states the user of mobile terminal 12 sends a payment request to network server 26 after receiving payment authorization. Apparently, the Examiner relies on column 4, lines 33-54, and column 6, line 48-column 7, line 10, of Rautila et al. for this proposition. However, column 4, lines 46-48, indicates the user of mobile terminal 12 sends the requested payment to the Internet server after receiving information from position transceiver 14. There is nothing in the relied upon portion of Rautila et al. to indicate the user of terminal 12 sends a payment request to the network server after receiving payment authorization.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

The same sentence bridging pages 4 and 5 of the Final Rejection states position transmitter 14 transmits acknowledgement and provides permission to the user to have access to services. Position transmitter 14 can not be the first device of claim 10 because position transmitter 14 has no long range transceiver. In consequence, the rationale set forth in the sentence bridging pages 4 and 5 of the Final Rejection for obviousness is contrary to the requirements of claim 10.

7. Independent claim 17 is not anticipated by Rautila et al.

In the rejection of independent claim 17, the Final Rejection incorrectly alleges "Rautila et al. teaches initiating communication between the second transceiver of the mobile terminal [i.e., first communications device] and the short-range transceiver vending machine or location based device [i.e., second communications device] to establish whether or not the at least one data transmitting unit has data required by the mobile terminal (column 7, lines 1-22, column 8, lines 30-41)." Column 7, lines 1-10 is not germane to the requirement to establish whether a second communications device has data required by required by a first communications device as result of a short-range communication between the first and second devices. Column 7, lines 11-22 indicates advertising information broadcast by position transceiver 14 of broadcast location 16 provides mobile terminal 12 with the ability to access IP network 26. Column 8, lines 30-41 merely indicates mobile terminal 12 includes a short-range transceiver, identified in column 8, line 45, as transceiver 44, and a network transceiver, identified in column 8, line 49 as transceiver 46. Consequently, column 7, lines 1-22 and column 8, lines 30-41 do not meet the requirement of claim 17 to establish whether a second communications device has data required by a first communication device as result of a short-range communication between the devices.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

Further, claim 17 includes the requirement of requesting permission for transfer of the required data from the second communications device to the first communications device.. Accordingly, Rautila does not anticipate claim 17.

D. Claims 6 and 7 are not obvious as a result of Rautila et al. (USP 6,549,625) and Ramachandran et al. (U.S. Pub. No. 2001/0044747).

In the last full paragraph on page 11 of the Final Rejection concerning claims 6 and 7, the Examiner states Rautila et al. teaches that the second transceiver of the first communications device communicates with the second communication device to inform the second communication device that authorization has been received. Following through with the rationale set forth in claim 1, upon which claims 6 and 7 depend, the second communication device is either vending machine 27''' or location base device 25. However, column 7, lines 7 and 8 of Rautila et al. indicate position transmitter 14, not vending machine 27''' or location base device 25, transmits the payment acknowledgement. Hence, this portion of Rautila et al. discloses subject matter contrary to the position set forth by the Examiner in connection with claim 1.

The rejection of claims 6 and 7 based on Rautila et al. and Ramachandran et al. is incorrect. The Examiner admits claims 6 and 7 differ from Rautila et al. by requiring downloading (claim 6) of music files (claim 7). The Final Rejection relies on circular reasoning resulting from Appellants' disclosure as to why one of ordinary skill in the art would have modified Rautila et al. to include the music download feature, by stating the motivation is to download the music. However, there is no suggestion in the references to combine them.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

E. Claims 8 and 9 are not obvious over Rautila et al. (USP 6,549,625) in view of Hitchings, Jr. (USP 6,594,484)

1. The obviousness rejection of claim 8 is wrong.

Item 15, page 12, of the Final Rejection admits Rautila et al. is deficient with regard to claim 8 because Rautila et al. does not disclose "inputting a list of required data files into a memory provided in the first communications device." The reliance on Hitchings, Jr. for this feature, in combination with Rautila et al., to meet the requirements of claim 8 is the result of hindsight.

Hitchings, Jr. is concerned with automatically navigating through a voice menu information system of a mobile device of a 2-way wireless interactive communication device 106, indicated by Figure 1 and in column 12, lines 7-15, to be a cell phone; the cell phone is shown in Figure 4 by reference numeral 402. As illustrated in Figure 4 and described in column 12, lines 17-37, wireless client device 402 includes an HDML choice card in the form of memory 420 that includes a list of choices, each corresponding to a selection that can be made with regard to available services and linked documents. An exemplary list consists of voice mail, voice call and accounts. The user selects one of the choices, each of which is displayed on screen 424. The selection is forwarded as a message to proxy server 404 via carrier wireless network 406. The message automatically requests the storage scripts that can be used on wireless client device 402 to obtain information from a voice menu information service 430. Upon receiving the message from wireless client device 402, proxy server 404 accesses the user account and then identifies storage scripts associated with the user account. The identified storage scripts are then forwarded to wireless client device 402 to enable the user to select one of the scripts to be executed.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

One of ordinary skill in the art would not have modified Rautila et al. to include such a feature in the first communications device, i.e., mobile terminal 12. In Rautila et al., short range transceiver 14 stores lists of required data files. The lists are transmitted to mobile terminal 12 by way of low power RF, short range link 24. In consequence, one of ordinary skill in the art would find no need for mobile terminal 12 to include a large memory including a list of required data files since such data files are available to mobile terminal 12 from short range transceiver 14.

2. Claim 9 is not obvious.

In rejecting claim 9, the paragraph bridging pages 12 and 13 of the Final Rejection states Hitchings, Jr. teaches the list of scripts, i.e., required data files, is communicated by the wireless client device, i.e., second transceiver of the first communications device. However, the second transceiver of the first communications device is defined in claim 1 as being a transceiver for communication at a second, higher data rate than a first transceiver that communicates at a first data rate over a long range. The Hitchings, Jr. disclosure fails to indicate wireless client device 106 or 402, i.e., a cell phone, includes such a short range transceiver. Consequently, the rejection of claim 9 has no basis from Hitchings, Jr.

F. Claim 11 is not obvious over Rautila et al. (USP 6,549,625) in view of Kumar et al. (U.S. Pub. No. 2002/0143634)

To reject claim 11, the Examiner erroneously states, in the second full paragraph on page 13 of the Final Rejection, that Rautila et al. discloses a payment facility communicating the cost of the intended purchase to a cash register associated with the user of the first communications device, i.e., mobile terminal 12. The Examiner relies on column 6, line 48-

Serial No. 09/875,266

Docket No. 30004777:1 US (1509-185)

column 7, line 10, of Rautila et al. for such a disclosure. However, the words "cash register" or any words equivalent thereto are not found in column 6, line 48-column 7, line 10. Consequently, a major premise for the rejection of claim 11 is incorrect.

The allegation in the third full paragraph on page 13 of the Final Rejection that Kumar et al., at page 4, paragraphs 0036-0040, discloses a banking facility associated with the user of the first communications device is incorrect. In fact, the relied upon portion of Kumar et al. fails to mention a first communications device that includes the first and second transceivers of the first communications device of claim 10. Claim 10 requires the first transceiver of the first communications device to communicate at a first data rate over a long range and the second transceiver to communicate at a second, higher data rate over a short range. The relied upon portion of Kumar et al. merely refers to a conventional cell phone, with no reference to first and second transceivers. Consequently, Kumar et al. does not disclose a banking facility that is associated with the user of a first communications device as set forth in claim 11.

G. Claims 12, 14 and 15 are not rendered obvious by Rautila et al. and Ramachandran et al.

1. Claim 12 is not obvious from Rautila et al. and Ramachandran et al.

The Examiner admits, in the last full sentence on page 13 of the Final Rejection, that Rautila et al. does not disclose a communications device having a music player, a memory and a processor for controlling downloading of music files to the memory and for transferring of music files from the memory to the music player. The rejection of claim 12 is defective because it fails to consider the requirement for the processor to be programmed to control a

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

short range high data rate transceiver from a similar communications device within the range of such a transceiver. There is no reason why the Ramachandran et al. Bluetooth communications port 18, that is described in Figure 1 as an output device, would include a transceiver. In other words, there is no reason why ATM 10 would include a Bluetooth receiver. Consequently, the allegations concerning Ramachandran et al. are inaccurate. Accordingly, claim 12 is not rendered obvious by the combination of Rautila et al. and Ramachandran et al.

2. Claim 14 is not obvious from Rautila et al. and Ramachandran et al.

The first full sentence on page 15 of the Final Rejection alleges that Ramachandran et al. requests permission from an ATM, which the Final Rejection equates with the service provider of claim 14, to download a given music file from a similar communication device that holds the music file in its stored device drive. However, the reliance on Ramachandran et al. for the similar communication device is contrary to the Examiner's position with regard to the similar communication device of claim 12, upon which claim 14 depends. In this regard, the rejection of claim 12 says the similar communication device is a mobile phone. In Ramachandran et al., all downloading of music files to ATM 10 is from website 32; see the first two paragraphs at the top of page 4, column 1, and paragraph 0051 of Ramachandran et al. Thus, the allegations in the Final Rejection concerning downloading a given music file from a similar communication device is contrary to the Ramachandran et al. disclosure and the rationale set forth for the rejection of the similar communication device in claim 12. Further, there is no basis from Ramachandran et al. to assume that website 32 is a communications device that is similar to the communications device of ATM 10. Because the rationale of the Office Action is wrong, the obviousness rejection of claim 14 is incorrect.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

The rejection of claim 14 is also incorrect because the alleged motivation for combining the references relies on circular reasoning derived from Appellants' disclosure. The alleged motivation to modify Rautila et al. as a result of Ramachandran et al. is to provide permission for downloading sound files. In Ramachandran et al., a music file is downloaded from ATM 10 to portable communication device 38 from port 28 in response to payment being made by the user of the portable communication device 38, see paragraph 0044. Alternatively, songs can be downloaded from ATM 10 to a portable computing device by way of port 18; see paragraph 0059. The transmitter of ATM 10 that sends messages to the mobile device cannot be considered as a device that is similar to the mobile device that includes wireless transmission and reception. There is no reason for ATM 10 to include, at its terminals that transmit songs to wireless device 38, a receiver from the wireless device.

3. Claim 15 is not rendered obvious by Rautila et al. and Ramachandran et al.

In the rejection of claim 15, the second sentence of the paragraph in the middle of page 15 of the Final Rejection states Ramachandran et al. discloses a processor programmed to control the mobile phone transceiver to request downloading music files once authorization is received from ATM 10; the Final Rejection relies on paragraphs 0044, 0050 and 0059-0062 of Ramachandran et al. for this feature. However, an inspection of these paragraphs fails to indicate that what the Examiner alleges to be a mobile phone, presumably wireless device 38, has a processor programmed to control downloading of the music file from a similar communications device once authorization is received from ATM 10. In Ramachandran et al., downloading of the music file by device 38 is from ATM 10, that does not include a mobile communications device. Consequently, ATM 10 cannot be considered the similar device, as

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

implied from claim 15, as a result of the requirement of claim 12 for the processor to be programmed to control the second, short-range high data rate transceiver to request downloading of a given music file from a similar communications device.

H. Claim 16 is not obvious as result of Rautila et al., Ramachandran et al. Pradhan et al., US Patent Publication 2002/0160793.

Firstly, Appellants note that the present invention and the Pradhan invention were co-owned at the time the inventions were made. Consequently, as a result of 35 U.S.C. 103(c), Pradhan et al. cannot be a reference under 35 U.S.C. 103(a).

In addition, the allegation in the first sentence of the second paragraph on page 16 of the Final Rejection that the Rautila et al. network server 26 is the similar communications device is contrary to the position set forth in the rejection of claim 12 that the similar communications device is the Ramachandran et al. mobile phone. The Rautila et al. network server 26 and the Ramachandran et al. mobile phone are not the same device, and they are not similar communication devices. Consequently, the rejection of claim 16 is improper.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)


VIII. Conclusion

Based on the foregoing arguments, all of the various rejections are incorrect and reversal thereof is in order.

Respectfully submitted,

John BRASSIL et al.

By:


Allan M. Lowe
Reg. No. 19,641

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400
Telephone: 703-684-1111
Facsimile: 970-898-0640

Randy Noranbrock
Registration No. 42,940

Date: April 6, 2006

AML:tal

Docket No. 30004777-1 US (1509-185)

PATENT**IX. Claims Appendix**

1. A method of transferring data to a first communications device having a first transceiver for communication at a first data rate over a long range, and a second transceiver for communication at a second, higher data rate over a short range, the method being performed by using a coordinated short-range wireless network including the first communications device and at least one second communications device of a similar type, the method comprising the steps of:

(a) initiating communication between the first communications device and said at least one second communications device to establish whether or not said at least one second communications device has data required by the first communications device;

(b) the first communications device communicating, upon the first communications device receiving confirmation that a second communications device has the required data, with a service provider using its first transceiver to request permission for the transfer of the required data from said second communications device to the first communications device; and

(c) transferring the required data from said second communications device to the first communications device following transmission by the service provider to the first communications device of authorisation.

2. A method as claimed in claim 1, wherein, prior to step (c), the service provider transmits provisional permission, together with a costing, to the first transceiver of the first communications device.

3. A method as claimed in claim 2, further comprising the step of the first communications device transmitting a message accepting the costing to the service provider using its first transceiver.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

4. A method as claimed in claim 3, further comprising the step of the service provider issuing an authorisation once acceptance of the costing has been received from the first communications device.
5. A method as claimed in claim 4, further comprising the step of the service provider communicating said costing to a network service provider of the first communications device.
6. A method as claimed in claim 4, wherein the second transceiver of the first communications device communicates, once the authorisation has been received, with said second communications device to inform that device that authorisation has been received and to request downloading of the required data.
7. A method as claimed in claim 1, wherein an mp3 file constitutes the required data.
8. A method as claimed in claim 1, further comprising an initial step of inputting a list of required data files into a memory provided in the first communications device.
9. A method as claimed in claim 8, wherein, during step (a), the list of required data files is communicated by the second transceiver of the first communications device to said at least one second communications device within the short-range wireless network.
10. A method of purchasing goods using a first communications device having a first transceiver for communication at a first data rate over a long range, and a second transceiver for communication at a second, higher data rate over a short range, the method comprising the steps of:

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

(a) inputting details of an intended purchase into a memory provided in the first communications device;

(b) transmitting details of said intended purchase, using the second transceiver of the first communications device, to any similar, in-range transceiver which communicates at the second, higher data rate over a short range, any such similar transceiver being associated with a respective supplier;

(c) receiving, at the second transceiver of the first communications device, a communication from any such similar transceiver indicating that said intended purchase is available and indicating its cost;

(d) the first communications device communicating, upon receiving said communication from said supplier, with a payment facility using its first transceiver; and

(e) the first communications device placing an order for said intended purchase with said supplier using its second transceiver in response to payment authorisation being received from the payment facility.

11. A method as claimed in claim 10, further comprising the step of the payment facility communicating the cost of said intended purchase to a banking facility associated with the user of the first communications device upon the first communications device communicating to the payment facility that said order has been made.

12. A communications device having a first transceiver for communication at a first data rate over a long range, a second transceiver for communication at a second, higher data rate over a short range, a music player, a memory, and a processor for controlling downloading of music files to the memory, and for transferring music files from the memory to the music player, the processor being

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

programmed to control the second transceiver to request downloading of a given music file at the second data rate from a similar communications device within the range of the second transceiver.

14. A communication device as claimed in claim 12, wherein the processor is programmed to control the first transceiver to request permission from a service provider to download said given music file from a similar communication device holding said music file in its memory.

15. A communications device as claimed in claim 14, wherein the processor is programmed to control the second transceiver to request downloading of said music file once authorisation is received from the service provider.

16. A communications device as claimed in claim 12, further including a filter for enabling only certain music files from the similar communications device to be downloaded from the second transceiver into the memory.

17. A method of transferring data to a first communications device having a first transceiver for wireless communication at a first data rate over a long-range link, and a second transceiver for wireless communication at a second, higher data rate over a short-range link, the method being performed by using a coordinated short-range wireless network including the first transceiver of the first communications device and a short-range transceiver of a second communications device, the short-range transceiver of the second communications device being arranged for wireless communication at the second, higher data rate, the method comprising the steps of:

(a) initiating communication between the second transceiver of the first communications device and the short-range transceiver of the second communications device,

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

(b) establishing whether said second communications device has data required by the first communications device as a result of the initial communication, the first communications device transmitting via the long-range link, upon the first communications device receiving confirmation that the second communications device has the required data, with a service provider using the first transceiver to request permission for transfer of the required data from said second communications device to the first communications device; and

(c) transferring the required data from said second communications device to the first communications device via the short-range link between the second transceiver of the first device and the transceiver of the second device, the transfer occurring following transmission, via the long-range link, by the service provider to the first communications device of authorisation.

18. The method of claim 1, further including:

transferring data to one of the at least one second communications device, said second communications device having a first transceiver for communication at the first data rate over a long range, and a second transceiver for communication at the second, higher data rate over a short range;

initiating communication between the second communications device and the first communications device to establish whether or not said first communications device has data required by the second communications device, the second communications device communicating, upon the second communications device receiving confirmation that the first communications device has the required data, with the service provider using its first transceiver to request permission for the transfer of the required data from said first communications device to the second communications device; and

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

transferring the required data from said first communications device to the second communications device following transmission by the service provider to the second communications device of authorisation.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

X. Evidence Appendix

None.

Serial No. 09/875,266

Docket No. 30004777-1 US (1509-185)

XI. Related Proceedings Appendix

None.

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.